

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Notice of references cited (PTO Form 892)

In reference to the applicant's reply dated August 13, 2008, the applicant reminds the examiner that U.S. patent 5,169,155 (Soules) applied in the 35 U.S.C. 103 rejection of the Office Action dated May 13, 2008 is not listed on the form 892. Instead, it appears that cited U.S. patent 6,169,155 (Alvarez) was inadvertently included instead of the *Soules '155* patent.

Applicant respectfully still requests that U.S. patent 5,169,155 (*Soules*) be added to the PTO form 892, and a correction be made with regard to the listing of U.S. patent 6,169,155 (*Alvarez*).

2. Rejection of claims 1, 4-11, 13, 16-19, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,506,476 (Kaule) in view of U.S. patent 4,455,039 (Soules) and further in view of U.S. patent 4,455,039 (Weitzen)

Reconsideration of this rejection is respectfully requested in view of the following observations on how the proposed combination of *Kaule*, *Soules* and *Weitzen* fails to render the pending claims *prima facie* obvious. Claims 1, 4-11, 13, 16-19, 30 and 31 are at least patentable in view of their dependency from independent claim 1.

In observing claim 1, the claim is drawn to a value document having at least two different feature substances for checking the document, wherein first and second feature substances form mutually independent codings.

As described in the specification at paragraphs [0009] and [0010], this arrangement allows a first group of users to use the first feature substance for authenticity checking and value recognition and a second group of users to use the second feature substance for authenticity checking and value recognition. With this arrangement,

knowledge of the procedure of one group does not reveal the substances and methods used for authenticity checking and value recognition by another group.

As pointed out in the applicant's previous remarks to a prior rejection of the claims, none of the cited references, whether considered individually or collectively, contemplate providing at least two different feature substances on the same value document for checking the value document, wherein first and second feature substances form mutually independent codings. As such, the proposed combination of *Kaule*, *Soules* and *Weitzen* fails to render independent claim 1 *prima facie* obvious.

The combination of *Kaule*, *Soules* and *Weitzen* describes only providing one feature substance on a substrate described in each of these references. The rejection appears to reason that because *Kaule* teaches the use of one feature substance (feature substance A), *Weitzen* teaches the use of another feature substance (feature substance B), and *Soules* discloses the concept of providing a spectral distribution itself which forms a coding, the rejection reaches the conclusion that it would be obvious to add feature substance A modified in accordance with *Soules* plus feature substance B on a value document. The applicant respectfully disagrees that the skilled person would reach such a conclusion from the combined teachings of *Kaule*, *Soules* and *Weitzen*.

First, it is submitted that the skilled person would not understand from *Kaule*, *Soules* and *Weitzen* to provide at least two different feature substances on the same value document for checking the value document, wherein first and second feature substances form mutually independent codings. The rejection primarily relies on the combination of *Kaule* and *Weitzen* for this limitation.

The rejection fails to provide the factual underpinnings which demonstrate that it would have been obvious to place the codings of *Kaule* and *Weitzen* on a single value document substrate. Instead, the rejection only provides reasoning derived from *Weitzen* that a coding is provided on a value document to make it more difficult to counterfeit (1:31-33). Presumably, both the single coatings of *Kaule* and *Weitzen* make the value documents thereof more difficult to counterfeit, yet the identified passage in *Weitzen* or

any other teaching among *Kaule* and *Weitzen* does not convey to skilled person the notion of two different feature substances each providing a coding independent from one another.

It will be noted that the bands (3), (4) and (5) of *Weitzen* combine to form a single bar code (1:37-41; 3:58-61), and are not independent from one another. As a result, *Weitzen* only describes a single coding.

*Soules* does not contribute anything more than the teachings of *Kaule* and *Weitzen* in that *Soules* only describes a "card code" (11) formed from a plurality of spaced apart wide bars extending from an upper margin (14) to a lower margin (15) (9:4-19; Fig. 1). The code taught by *Soules*, therefore, is a single code, and does not represent the different codes formed by different substances required by the pending claims.

Accordingly, it is submitted that the skilled person would not understand from *Kaule*, *Soules* and *Weitzen* the notion of the value document according to claim 1 having two feature substances forming independent codings.

Next, none of *Kaule*, *Soules* and *Weitzen* or any combination thereof would teach that a first feature substance is formed by at least one of a luminescent substance and a mixture of luminescent substances, having a complex spectral distribution, wherein the spectral distribution itself forms a coding.

As acknowledged in the Action, nowhere is there any understanding in the teachings of *Kaule* and *Weitzen* of using a feature substance having the characteristics of the first feature substance in amended claim 1.

*Kaule* does not disclose the use of a mixture of luminescent substances, and only describes that different substances can be used. There is no understanding of the luminescent substances having a complex spectral distribution which forms a coding itself.

*Weitzen* only teaches that one of the coding may be formed by a luminescent substance with the various bands combining to form a single code.

*Soules* is relied upon in the rejection to make up for the shortcomings of *Kaule* and *Weitzen* on this limitation as to the manner in which the first feature substance is formed. However, it is submitted that *Soules* does not teach this limitation of claim 1.

Specifically, there is no understanding in *Soules* of using a feature substance having a complex spectral distribution which itself forms a coding.

The rejection relies on col. 4, ll. 42-46 of *Soules* as teaching this limitation, but such a reliance on this passage is misplaced. Indeed, this passage only indicates to the skilled person that playing cards may be provided with machine readable indicia or card code invisible to the human eye. The rejection also relies on Fig. 1, in which the specification refers to such embodiment of *Soules* in column 9. This column, however, only discloses that playing cards may be provided with crystals which absorb in the near-infrared or near-ultraviolet range (col. 9, ll. 45-56).

Moreover, *Soules* teaches that the code may be formed from inorganic or organic particles which are chosen to fluoresce in the visible or infrared range, and that the marking substances are recognizable in the infrared or ultraviolet range may be printed over one another (col. 11, ll. 1-68).

From these observations, it would be clear to the skilled person that that there is no understanding in *Soules* of the concept of providing substances which fluoresce in infrared or ultraviolet range which react upon an excitation. Further, *Soules* does not explain how the respective spectra might be represented. Accordingly, *Soules* (as with *Kaule* and *Weitzen*) neither suggests nor discloses the limitation that a feature substance may be formed with special characteristics which represents a coding.

Accordingly, the combination of *Kaule*, *Soules* and *Weitzen* fails to disclose or suggest the value document according to claim 1. Claim 1 is therefore patentable. The claims dependent from claim 1 are at least patentable based on their dependency from claim 1 and their individually recited features.

Amended claim 18 describes a method for forming a value document having the characteristics of the value document of claim 1. The particular steps required by amended claim 18 would likewise not be understood by the combination of *Kaule*, *Soules* and *Weitzen*.

From the foregoing, amended claim 18 is therefore patentable. The claims dependent from claim 18 are at least patentable based on their dependency from claim 18 and their individually recited features.

Withdrawal of this rejection is respectfully requested.

4. Rejection of claims 2, 3 and 21-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,506,476 (*Kaule*) in view of U.S. patent 4,455,039 (*Soules*) and further in view of U.S. patent 4,455,039 (*Weitzen*) and U.S. patent 6,491,324 (*Schmitz*)

Reconsideration of this rejection is respectfully requested in light of the observations noted above with respect to independent claim 1, from which claims 2 and 3 depend, independent claim 18 from which claims 21 depends, and independent claim 22 from which depend claims 23-29 depend. The foregoing observations on claims 1 and 18 apply equally as well to claim 22.

It is submitted that *Schmitz* does not make up for the basic shortcomings of *Kaule*, *Soules* and *Weitzen*. Thus, claims 2, 3 and 21-29 are patentable. Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claims 12, 14, 15, 20 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,506,476 (*Kaule*) in view of U.S. patent 4,455,039 (*Soules*) and further in view of U.S. patent 4,455,039 (*Weitzen*) and U.S. patent application publication 2004/0084277 (*Blair*)

Reconsideration of this rejection is respectfully requested in light of the observations noted above with respect to independent claim 1, and independent claim 18. Claims 12, 14, 15, 20 and 32 depend from one of claims 1 and 18, and are at least patentable based on their dependency from one of claims 1 and 18.

It is submitted that *Schmitz* does not make up for the basic shortcomings of *Kaule*, *Soules* and *Weitzen*. Thus, claims 12, 14, 15, 20 and 32 are patentable. Accordingly, withdrawal of this rejection is respectfully requested.

6. Co-pending applications

The applicant reminds the examiner that this application is related to co-pending U.S. applications 10/574,838, 10/575,074, 10/575,080 and 10/575,079.

7. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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